UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,392	10/17/2000	Ronald A. Katz	244/068	3722

29129 7590 01/24/2003

ROCCO L. ADORNATO
C/O WEST CORPORATION
11808 MIRACLE HILLS DR.
MAIL STOP: W11-LEGAL
OMAHA, NE 68135

EXAMINER
MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 01/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/691,392	KATZ ET AL.	
	Examiner	Art Unit	
	James S McClellan	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-43* is/are pending in the application.

4a) Of the above claim(s) *1-20,25-33 and 41* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-24,34-40,42 and 43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 October 2000* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A-1: On-screen Programming (see Figure 12).

Species A-2: Geographical Position (see Figure 11).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

If Applicant elects Species A-1, then Applicant is required to elect from following patentably distinct species of the claimed invention:

Species B-1: Visual display is a television;

Species B-2: Visual display is a computer;

Species B-3: Visual display is a monitor;

Species B-4: Visual display is flat panel; and

Species B-5: Visual display is a wireless device.

In addition, if Applicant elects Species A-1, then Applicant is required to elect from following patentably distinct species of the claimed invention:

Species C-1: Communication link is a cable connection;

Species C-2: Communication link is a telephonic connection;

Species C-3: Communication link is a satellite connection;

Species C-4: Communication link is a digital connection; and

Species C-5: Communication link is a Internet connection.

If Applicant elects Species A-2, then Applicant is required to elect from following patentably distinct species of the claimed invention:

Species D-1: Electronic communication is wireless and

Species D-2: Electronic communication is wired.

In addition, if Applicant elects Species A-2, then Applicant is required to elect from following patentably distinct species of the claimed invention:

Species E-1: Geographic position is determined by a GPS;

Species E-2: Geographic position is determined by a base station;

Species E-3: Geographic position is determined by a telephone number;

Species E-4: Geographic position is determined by a network; and

Species E-5: Geographic position is determined by input from a user.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Rocco Adornato and David Murphy on January 9, 2003 a provisional election was made without traverse to prosecute the invention of Species A-2 (Geographical Position), D-1 (wireless), and E-1 (GPS), claim 21-24, 34-40, 42, and 43. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-20, 25-33, and 41 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

4. The drawings are objected to because element number 84 (lower most occurrence) of Figure 3, should be replaced with 82. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 130 (see page 28, line 21). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "134" has been used to designate two different elements (web access and web access connection) as shown in Figure 3. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

7. The disclosure is objected to because of the following informalities:

on page 16, line 12, satellite should be replaced with --system--;

on page 25, line 3, "42" should be replaced with --44--;

on page 26, line 21, "89" should be replaced with --86--; and

on page 30, line 5, element "70" appears to be incorrect since "70" refers to an upsell system, not a "path".

Generally, the acronym GPS stands for global positioning system, not global positioning satellite. Since GPS is a system of satellites and receivers, the Examiner requests that each occurrence of "global positioning satellite" be replaced with the commonly used term "global positioning system". Appropriate correction is required.

Claim Objections

8. Claim 38 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 38 fails to further limit claim 37. Claim 38 adds that "the offer expires at a certain time" which is the same as "the offer is time limited."

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 21-24, 34-40, 42, and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites the limitation "the item" in line 9. There is insufficient antecedent basis for this limitation in the claim. Claim 39 recites the limitation "the offeror system" in line 2. There is insufficient antecedent basis for this limitation in the claim. Claim 40 recites the limitation "an offer" in line 1. Does Applicant intend to refer to the originally claim offer in claim 21 or a second offer in claim 40. The Examiner recommends replacing in claim 40, line 1, "an offer" with --said offer--.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73

USPQ 482 (CCPA 1947). The term "GPS" in claim 24 is used by the claim to mean "global positioning satellite," while the accepted meaning is "global position system."

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 21, 22, 24, 34, 35, 37-40, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,317,718 (Fano).

In regards to independent **claim 21**, Fano discloses a method for providing offers of a good, a service or information, utilizing an electronic communications device, between an offeror and a user of the electronic communication device, comprising the steps of: receiving geographical information (see column 2, line 43, "physical location of the user") regarding the geographic position of the user, determining the identity of the user (see ABSTRACT, lines 5-6), utilizing at least in part the geographic position of the user and the identity of the user to determine an offer for a good, service or information, and offering an item to the user (see ABSTRACT, lines 7-13); **[claim 22]** the electronic communication device (PDA) is a wireless device; **[claim 24]** the geographic position information is determined by a global positioning system (GPS, see ABSTRACT, line 2); **[claim 34]** the position information is utilized to obtain

information regarding an attribute of the geographic location (proximity to retail stores); **[claim 35]** the attribute information is utilized in determining the offer (see final line of ABSTRACT); **[claim 37]** the offer is time limited (inherent); **[claim 38]** the offer expires at a certain time (inherent); **[claim 39]** the offeror system contacts the user via the electronic communications device (see Figure 26); **[claim 40]** the determination of an offer is subject to negative decision criteria (inherent since the system utilizes user profile and location information, it is inherently negating possible offers); and **[claim ~~42~~ 43]** the offer is made visually to the user (see visual display in Figure 27).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 23, 36, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of U.S. Patent No. 6,389,337 (Kolls).

Fano discloses all of the elements as set forth above except for **[claim 23]** the wireless device is a wireless phone; **[claim 36]** the offer comprises a coupon; and **[claim 42]** the offer is made orally to the user.

Kolls teaches the use of e-commerce method utilizing a wireless phone (312) to offer a coupon (see ABSTRACT line 13), wherein the offer is made orally to the user (via element 124).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fano with the use of a wireless phone device that offered coupons orally as taught by Kolls, because some potential customers may not have access to a PDA and a wireless phone can receive offer information and then present the offer orally, wherein using a wireless phone increases the number of customers that would have access to the system. Utilizing a coupon as an offer provides an attractive incentive to promote customer acceptance of an offer.

15. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of U.S. Patent No. 6,434,532 (Goldband et al.).

If it is held that Fano fails to inherently disclose an offer that is time limited, then Goldband et al. is relied upon to teach the use of a time-limited offer (see ABSTRACT, lines 23-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fano with a time-limited offer as taught by Goldband et al., because time-limited offers expedite the response of the customer to accept an offer.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Beri et al. is cited of interest for disclosing a system and method of tracking an item in an e-commerce environment.

Saylor et al. is cited of interest for disclosing a system that utilizing a GPS within a mobile phone.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 305-7687 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

James S. McClellan
Patent Examiner
A.U. 3627

jsm
January 10, 2003